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NOTICE OF ALLOWANCE AND FEE(S) DUE

7590 01/02/2002

RADER, FISHMAN & GRAUER, PLLC
1233 20TH STREET, N. W.
SUITE 501
WASHINGTON, DC 20036-5339

EXAMINER

SUNDARAM, T R

ART UNIT

CLASS-SUBCLASS

2858

324-631000

DATE MAILED: 01/02/2002

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,583	09/08/1999	SHINICHI NAGATA	P7331-9002	2806

TITLE OF INVENTION: ORIENTATION MEASURING INSTRUMENT

TOTAL CLAIMS	APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
12	nonprovisional	NO	\$1280	\$0	\$1280	04/02/2002

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above. If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

B. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and mail this form, together with applicable fee(s), to:

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MAILING INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

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RADER, FISHMAN & GRAUER, PLLC
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SUITE 501
WASHINGTON, DC 20036-5339

Note: The certificate of mailing below can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing.

Certificate of Mailing

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Box Issue Fee address above on the date indicated below.

	(Depositor's name)
	(Signature)
	(Date)

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EXAMINER	ART UNIT	CLASS-SUBCLASS
SUNDARAM, T R	2858	324-631000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363). Use of PTO form(s) and Customer Number are recommended, but not required.

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47) attached.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) ☐ individual ☐ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

☐ Issue Fee

☐ Publication Fee

☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):

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☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

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(Authorized Signature)

(Date)

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Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending on the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, United States Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND FEES AND THIS FORM TO: Box Issue Fee, Assistant Commissioner for Patents, Washington, D.C. 20231

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UNITED STATES

EXAMINER

SUNDARAM, T R

ART UNIT

PAPER NUMBER

2858

DATE MAILED: 01/02/2002

Determination of Patent Term Extension under 35 U.S.C. 154 (b)
(application filed after June 7, 1995 but prior to May 29, 2000)

The patent term extension is 0 days. Any patent to issue from the above identified application will include an indication of the 0 day extension on the front page.

If a continued prosecution application (CPA) was filed in the above-identified application, the filing date that determines patent term extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system. (<http://pair.uspto.gov>)

Notice of Allowability

Application No.

09/380,583

Applicant(s)

Shinichi Nagata et al.

Examiner

T. R. Sundaram

Art Unit

2858



--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE filed December 14, 2001.
2. ☒ The allowed claim(s) is/are 1-12.
3. ☐ The drawings filed on _____ are acceptable as formal drawings.
4. ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____.

5. ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

6. ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.
7. ☒ Applicant MUST submit NEW FORMAL DRAWINGS
- (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☒ to Paper No. 3.
- (b) ☒ including changes required by the proposed drawing correction filed Apr 24, 2001, which has been approved by the examiner.
- (c) ☐ including changes required by the attached Examiner's Amendment/Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

8. ☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any reply to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

- 1 ☐ Notice of References Cited (PTO-892)
- 3 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 5 ☒ Information Disclosure Statement(s) (PTO-1449), Paper No(s). 4
- 7 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 9 ☐ Other
- 2 ☐ Notice of Informal Patent Application (PTO-152)
- 4 ☐ Interview Summary (PTO-413), Paper No. _____
- 6 ☐ Examiner's Amendment/Comment
- 8 ☒ Examiner's Statement of Reasons for Allowance

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed April 24, 2001 has been received and it has been placed of record in the application file.

Earlier Final Rejection and the Filing of an RCE

2. In a First Office Action on Merits (FOAM) that was issued on the subject application on October 24, 2000 (paper # 3), claims 1-12 (with claims 1, 2 and 3 being independent claims), had been rejected under 35 U.S.C. 103(a) as being unpatentable over *King*, in view of *Osaki et al.*, *Heikkila* and *Todoroki et al.* Since in their response to the FOAM, received by the Office on April 24, 2001, the Applicants had not made any amendments to the claims in light of the rejections given in the FOAM, but had merely traversed the rejections (with arguments that were deemed to be unpersuasive), the earlier rejections were reaffirmed and the rejection was made FINAL (paper # 8).

The Applicants have now filed a Request for Continued Examination (RCE), paper # 10, along with a preliminary amendment (paper # 12), in which they have amended the independent claims 1, 2 and 3. They have also provided further detailed arguments in favor of the patentability of the amended claims.

The following is an Office Action on the RCE.

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Action on the RCE

3. As already noted above, the Applicants have now amended claims 1-3 to more clearly distinguish their invention from prior art. Specifically, the amended claims now recite that the dielectric resonators are arranged on a first surface of the sample under test in the subject orientation measuring instrument and that the instrument measures the orientation of a portion of the sample. These amendments are deemed to render the claims novel and patentable over prior art. Therefore claims 1-12 are now allowed.

The arguments presented by the Applicants on pages 3-12 of the amendment (paper # 12) merely restate, for the most part, arguments they had presented in earlier responses. These arguments were already addressed in full in the earlier final rejection (paper # 8, pages 9-16); therefore, we shall not consider them again. Suffice it to say that had the Applicants **not** amended the claims as they have done, the earlier rejections would have been reaffirmed in this Office action.

One particular point about the Applicants' arguments must, however, be considered for the record. The Applicants state (page 10 of the amendment) that they "understand the examiner's confusion about the Doctrine of Equivalence, as this Doctrine is only applicable when dealing with the subject of claim infringement, and has no bearing on the determination of patentability." To show that the Examiner is not "confused," we only need to refer the Applicants to MPEP § 904.01(b), 2144.06, 2183 and 2184. It is a well-established concept in determining patentability (indeed, all of Section 2100 deals with "Patentability") that substitution of functional or

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mechanical equivalents for a claimed component can be used as a rationale supporting an obviousness rejection (MPEP 2144.06). Specifically, the MPEP states that: "If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed invention is **anticipated** by the prior art element" (MPEP 2183, emphasis added).

Even if the Applicant is able to show that "the prior art element is not equivalent to the structure" (MPEP 2183), the Examiner must still make a determination of obviousness; that is, any showing by the Applicant "does not prevent the prior art element from rendering the claim limitation **obvious** to one of ordinary skill in the art" (emphasis added).

Thus, finding of equivalence applies to **both** anticipation and obviousness rejections, **in the examination process**, and is **not** limited to claim infringement considerations.

We reiterate that had the Applicants **not** amended the claims as they have done, the Examiner would have reaffirmed the earlier rejections.

Reasons for Allowance

4. The following is an examiner's statement of reasons for allowance:

Prior art does not disclose a orientation measuring instrument in which the dielectric resonators are arranged on a first surface of the sample under test and that the instrument measures the orientation of a portion of the sample.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

5. Any inquiry concerning this communication should be directed to Dr. T. R. (Joe) Sundaram at telephone number (703) 308-6821. If attempts to reach the Examiner by phone are unsuccessful, the Examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436.



TRS

Christine K. Oda
Christine Oda
Primary Examiner

December 27, 2001